



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,273	10/27/2003	Rajiv R. Singh	H0003965-4510	2796
128	7590	03/08/2006	EXAMINER	
HONEYWELL INTERNATIONAL INC. 101 COLUMBIA ROAD P O BOX 2245 MORRISTOWN, NJ 07962-2245			KHAN, AMINA S	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/694,273	Applicant(s) SINGH ET AL.	
	Examiner Amina Khan	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) 1-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 54-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-68 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/27/2003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

There exists a discrepancy between the oath and the specification with regards to the filing dates of Provisional applications 60/421,263 and 60/421,435. In the specification, page 1, lines 6 and 7, the filing date assigned to the applications was October 25, 2002. However, in the oath submitted on 3/4/2004, on page 2, the filing dates assigned to the provisional applications is October 25, 2003. Appropriate correction of the filing dates for provisional applications 60/421,263 and 60/421,435 in oath is required.

Election/Restrictions

Applicant's election of Group IV, claims 54-68 in the reply filed on February 16, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 1-53 have been withdrawn from consideration.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 54-68 are rejected under 35 U.S.C. 102(b) as being anticipated by Tapscott (US 6,300,378).

Tapscott teaches compositions comprising bromine-containing alkenes (column 9, lines 45-61), for example $\text{CH}_2=\text{CHCF}_2\text{Br}$ or $\text{CH}_2=\text{CBrCF}_3$, as claimed in claims 54 and 56-59, in combination with refrigerants, foam blowing agents, solvents, propellants and sterilants (column 11, lines 13-16), as claimed in claim 54 and 65. Tapscott further teaches that the compositions comprise 1-80% bromine-containing additive, specifically 5-50% for foam blowing agents (column 10, lines 51-62) as claimed in claim 64. Tapscott further teaches that the compositions have low (near zero) global warming potentials (column 11, lines 39-42), as claimed in claim 55. Tapscott further teaches that the hepatotoxicity is reduced by at least partially fluorinating (column 7, lines 47-50) as claimed in claims 66-68. Tapscott further teaches that the compositions may further contain 0.1-99% bromine-containing alkene combined with siloxanes, ketones, ethers (column 12, claim 1) among other solvents well known in the art to be efficient lubricants, compatibilizers and stabilizers as claimed in claims 60,61 and 63.

While Tapscott is silent as to the percentage of solvent, if at least 50% bromine-containing alkene was utilized, greater than 30% by weight lubricant, such as siloxane could be utilized as claimed in claim 62.

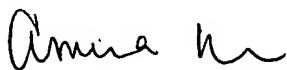
Regarding the claimed properties of no substantial or low acute toxicity, as claimed in claims 66 and 67, while Tapscott is silent to these properties, they would be inherent to the compositions taught by Tapscott because Tapscott teaches similar components at similar claimed percentages. Furthermore, Tapscott clearly suggest reducing the hepatotoxicity of his compositions by partially fluorinating them.

Accordingly, the teachings of Tapscott anticipate the material limitations of the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amina Khan whose telephone number is (571) 272-5573. The examiner can normally be reached on Monday through Friday, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Amina Khan, PhD
Patent Examiner
March 2, 2006



MARGARET EINSMANN
PRIMARY EXAMINER
GROUP 1100